

### **REMARKS**

Claims 1-3, 5, 6, 8, 10 and 13 are amended; support for the amendments can be found in at least ¶¶ [0058]-[0062] and FIGs. 2, 4 and 5 of the present application. Claim 7 is canceled. Claims 18-20 are new; support for the newly-added claims can be found in at least ¶ [0061] and FIG. 3 of the present application. Claims 1-6 and 8-20 are pending. Applicant reserves the right to pursue the original and other claims in this and other applications.

Claim 13 stands objected to as being informal. Applicant submits that the claim has been amended to incorporate the changes suggested by the Examiner. Accordingly, the objection should be withdrawn.

Claim 13 stands rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the enablement requirement. Specifically, the Office is concerned with the recitation of “an expandable body which is hydraulically separated from the conductive liquid.” (Office Action at 2). Claim 13 has been amended to clarify that “said interior space is enclosed by an expandable auxiliary body that hydraulically separates said surface element from said interior space.” As discussed in ¶ [0062] of the specification, “the interior space 13 of the treatment electrode 10 is enclosed by an elastic, stretchable auxiliary body 14 which is completely water-tight.” (¶ [0062]). FIGs. 4 and 5 illustrate that the auxiliary body 14 is disposed between the surface element 11 and the interior space 13, such that the two elements are hydraulically separated. Accordingly, the rejection should be withdrawn.

Claim 13 also stands rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. This rejection is respectfully traversed. Applicant submits that claim 13 has been amended to clarify that “liquid can be directed perpendicular to the outer surface of the element.” Accordingly, the rejection should be withdrawn.

Claims 1, 6-13 and 15-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,797,903 to Swanson, et al. (“Swanson”). This rejection is respectfully traversed.

Claim 1 defines an apparatus for the interstitial coagulation of tissue and recites “a first three-dimensional treatment electrode that can be expanded to various states of expansion during use ... such that by one of continuous and stepwise expansion of said electrode it can be kept in constant electrical contact with the tissue during coagulation [and] one of an elastically stretchable and an unfoldable surface element that defines a hydraulically separate interior space to which an internal pressure can be applied to expand said surface element and thereby said treatment electrode.”

Swanson does not disclose such limitations. Swanson only discloses a tissue ablation system with an “expandable-collapsible body 22 ... that can be altered between a collapsed geometry (FIG. 3) and an enlarged, or expanded geometry (FIG. 2).” (Swanson, col. 5, lns. 10-20; FIGs. 2-3). Swanson teaches that the expandable-collapsible body 22 is designed to facilitate “collapsed, low profile” insertion into the vasculature. (Swanson, col. 5, lns. 32-37). In other words, Swanson’s body 22 is either collapsed, or expanded. There is no disclosure of any operation in an intermediate state. Nowhere does Swanson disclose that its body 22 “can be expanded to various states of expansion during use ... such that by one of continuous and stepwise expansion of said electrode it can be kept in constant electrical contact with the tissue during coagulation.”

Another reason why Swanson fails to teach the above limitations is that Swanson’s body 22 is *not* “a ... three-dimensional treatment electrode.” To the contrary, Swanson positions its electrode 30 *within* body 22, which is made of *non-conductive* thermoplastic or elastomeric material, and uses electrically conductive liquid to establish a conductive path to the tissue. (Swanson, col. 6, lns. 19-21). Only pores 44 in the body 22 enable current to flow between the electrode and the tissue.

Furthermore, Swanson does not disclose “an elastically stretchable and an unfoldable surface element that defines a hydraulically separate interior space to which an internal pressure can be applied to expand said surface element and thereby said treatment electrode,” either. As is discussed above, Swanson merely teaches a porous, non-conductive, “expandable-collapsible body 22.”

As Swanson does not teach each and every limitation of claim 1, Swanson does not anticipate claim 1. Claims 6-13 and 15-16 depend from claim 1 and are allowable for at least the same reasons, as well as on their own merit. Accordingly, the rejection should be withdrawn and the claims allowed.

Claims 1, 6 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,837,885 to Koblish, et al. (“Koblish”). This rejection is respectfully traversed.

Claim 1 defines an apparatus for the interstitial coagulation of tissue and recites “a first three-dimensional treatment electrode ... [comprising] one of an elastically stretchable and an unfoldable surface element that defines a hydraulically separate interior space to which an internal pressure can be applied to expand said surface element and thereby said treatment electrode.”

Koblish does not disclose a “hydraulically separate interior space to which an internal pressure can be applied to expand said surface element and thereby said treatment electrode,” as recited by claim 1. As is clearly illustrated in FIG. 4 and discussed in col. 7, Koblish’s inflatable therapeutic element is a single chamber filled *entirely* with electrically conductive fluid. (Koblish, FIG. 4; col. 7, lns. 1-8). No “hydraulically separate interior space” is illustrated or discussed.

Furthermore, Koblish suffers from the same problem discussed above with respect to Swanson—therapeutic element 14 is formed from an electrically non-conductive or semi-conductive thermoplastic or thermosetting plastic material, and micropores 28 allow the transmission of electrically conductive fluid to the tissue. (Koblish, col. 6, ln. 65-col. 7, ln. 35). Koblish’s therapeutic element 14 is *not* “a ... three-dimensional treatment electrode.”

For at least these reasons, Koblish does not anticipate claim 1. Claims 6 and 14 depend from claim 1 and are allowable for at least the same reason, as well as on their own merit. Accordingly, the rejection should be withdrawn and the claims allowed.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson. This rejection is respectfully traversed.

Claim 17 depends from claim 1, and is allowable for at least the same reasons discussed above with respect to claim 1, as well as on its own merit. Specifically, Swanson does not teach or suggest anything but a porous, non-conductive “expandable-collapsible body 22.” Accordingly, the rejection should be withdrawn and the claim allowed.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson in further view of U.S. Patent No. 5,545,195 to Lennox. This rejection is respectfully traversed.

Claim 5 depends from claim 1, which is allowable over Swanson for at least the same reasons discussed above, as well as on its own merit. Lennox, which is cited as teaching a measurement device, does not cure the deficiencies of Swanson. Accordingly, claim 5 is believed allowable over the cited combination and Applicant respectfully requests that the rejection be withdrawn and the claim allowed.

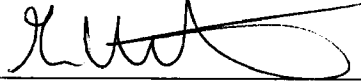
Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koblish, in further view of U.S. Patent No. 5,496,311 to Abele et al. (“Abele”). This rejection is respectfully traversed.

Claims 2-4 depend from claim 1 and are allowable over Koblish for at least the same reasons discussed above with respect to claim 1, as well as on their own merit. Abele, which is cited as teaching a control device, does not cure the deficiencies of Koblish. Accordingly, claims 2-4 are believed allowable over the cited combination and Applicant respectfully requests that the rejection be withdrawn and the claims allowed.

In view of the above, Applicant believes the pending application is in condition for allowance. If there are any additional fees or charges due in connection with this filing, the Examiner is respectfully requested and authorized to charge Deposit Account No. 04-1073 under Order No. E7900.2052/P2052.

Dated: April 30, 2009

Respectfully submitted,

By 

Gianni Minutoli

Registration No.: 41,198

Matthew B. Weinstein

Registration No.: 62,202

DICKSTEIN SHAPIRO LLP

1825 Eye Street, NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicant